

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL R. FORTIN and ROBERT J. URQUHART

Appeal No. 1998-0718
Application No. 08/400,779

ON BRIEF

Before HAIRSTON, JERRY SMITH and BARRY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 2, 4, 7-9, 12 and 13, which constitute all the claims remaining in the application. The final rejection of claims 1 and 2 is not being appealed. Therefore, this appeal relates only to the rejection of claims 4, 7-9, 12 and 13. An amendment after final rejection was filed on May 7, 1997 but was denied entry by the examiner.

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The disclosed invention pertains to a method and apparatus for monitoring the execution of a software program on a computer system.

Representative claim 4 is reproduced as follows:

4. A system for monitoring execution of a software program having a plurality of executable instructions on a computer system, said system comprising:

storage means for storing a plurality of monitoring programs;

instrumentation means for modifying said software program for execution monitoring by replacing one of said plurality of executable instructions with an invocation of a first one of said plurality of monitoring programs, said instrumentation means comprising:

means for copying one of said plurality of instructions to said first monitoring program;

means for replacing said one of said plurality of instructions in said software program with an instruction invoking said first monitoring program; and

means for returning control from said first monitoring program to said software program upon completion of said first monitoring program; and

means for invoking a second of said plurality of monitoring programs from said first monitoring program before returning control to said software program.

The examiner relies on the following references:

Haswell-Smith

4,866,665

Sep. 12, 1989

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Will	5,129,087	July 07, 1992
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Claims 4, 7-9, 12 and 13 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Haswell-Smith in view of Will.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 4, 7-9, 12 and 13. Accordingly, we reverse.

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In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie

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case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision.

Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

Independent claims 4 and 9 are drafted in similar functional means language except that claim 4 is directed to a system whereas claim 9 is directed to a computer program product. The examiner essentially rejects claims 4 and 9 on the same rationale. Specifically, the examiner notes that Haswell-Smith teaches a system for monitoring the execution of a computer program, but the examiner recognizes that Haswell-

Smith does not teach the plurality of monitoring programs as claimed [answer, pages 3-5]. Will teaches a system for monitoring data structures representative of a plurality of users in a distributed computer processing system. Although Will has apparently nothing to do with monitoring execution of a software program (as intended by Haswell-Smith and appellants), the examiner finds the claimed plurality of monitoring programs to be broadly met by the control blocks of Will which are assigned to each individual user. The examiner asserts the obviousness of applying the teachings of Will to the system of Haswell-Smith to provide that system with enhanced capability [id.]. The examiner also points to a teaching of Bolosky [answer, page 6] although Bolosky is no longer a reference being relied on.

Appellants argue that Haswell-Smith does not teach a plurality of monitoring programs as recited in the claimed invention and that Will also does not teach a plurality of monitoring programs despite the examiner's assertions to the contrary. Appellants argue that the monitoring units of Will only monitor the status of a connected user and not the instructions of a computer program. Thus, appellants argue

that neither Haswell-Smith nor Will teaches the chain of monitoring programs as recited in the claims. Appellants also argue that Haswell-Smith and Will come from non-analogous art areas and there would be no valid rationale for combining their teachings [brief, pages 5-9].

Although some of appellants' comments in the brief appear to be directed to the invention of claim 1 which is not being appealed, we nevertheless agree with most of appellants' arguments as set forth in the brief. Specifically and most critically, we agree with appellants that Will is completely unrelated to the chaining of a plurality of monitoring programs for monitoring execution of a software program. We find the examiner's attempt to interpret the claim language as broad enough to be met by Will's control modules to be untenable. Will not only provides no basis for making the modification of Haswell-Smith proposed by the examiner, but we fail to see how the modification proposed by the examiner actually results in the invention being claimed because Will relates only to the monitoring of a plurality of data structures, not software programs. The combination of

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Haswell-Smith and Will is nothing more than an improper attempt to reconstruct appellants' invention in hindsight.

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Therefore, we do not sustain the rejection of the
appealed claims based on the teachings of Haswell-Smith and
Will. Accordingly, the decision of the examiner rejecting
claims 4, 7-9, 12 and 13 is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JERRY SMITH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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LANCE LEONARD BARRY)	
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